

REMARKS / DISCUSSION OF ISSUES

Claims 1-15 are pending in the application. Unless indicated to the contrary, claims are amended for non-statutory reasons, such as to replace European-style phrasology in order to present the claims more properly for US practice.

Rejections under 35 U.S.C. § 102

Claims 1, 10 and 13-15 are rejected under U.S.C. § 102(e) as being anticipated by *Taylor* (US Patent 6,558,231) and *Zhou, et al.* (US Patent 6,403,931). For at least the reasons set forth herein, Applicants respectfully submit that this rejection is improper and should be withdrawn.

A proper rejection of a claim under 35 U.S.C. § 102 requires that a **single prior art reference disclose each element of the claim.** *See, e.g., W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303, 313 (Fed. Cir. 1983). **Anticipation requires that each and every element of the claimed invention be disclosed in a single prior art reference.** *See, e.g., In re Paulsen*, 30 F.3d 1475, 31 USPQ2d 1671 (Fed. Cir. 1994); *In re Spada*, 911 F.2d 705, 15 USPQ2d 1655 (Fed. Cir. 1990). Alternatively, anticipation requires that **each and every element of the claimed invention be embodied in a single prior art device or practice.** *See, e.g., Minnesota Min. & Mfg. Co. v. Johnson & Johnson Orthopaedics, Inc.*, 976 F.2d 1559, 24 USPQ2d 1321 (Fed. Cir. 1992). **For anticipation, there must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention.** *See, e.g., Scripps Clinic & Res. Found. v. Genentech, Inc.*, 927 F.2d 1565, 18 USPQ2d 1001 (Fed. Cir. 1991). (Emphasis added in each instance.)

i. Rejection in view of *Taylor* and *Zhou, et al.*

i. The rejection of claims 1, 10 and 13-15 for anticipation improperly relies upon multiple references

At the outset, Applicants respectfully traverse the rejection of claim 1, 10 and 13-15 based on the applied references to *Taylor* and *Zhou, et al.* The rule of law with regard to rejection for anticipation mandates that a **single prior art reference disclose each element of the claim**. Accordingly, the application of both *Taylor* and *Zhou, et al.* is not compliant with this rule of law, and therefore the rejection for anticipation based on the combination of these two references is patently improper and should be withdrawn.

In furtherance of their position, Applicants note that the Examiner has provided is no basis in law for the combining of two patent references into one for the purposes of establishing anticipation by incorporation by reference of one reference in another. To this end, incorporation by reference is provided for under 37 C.F.R. § 1.57(a), which states, *inter alia*:

(a) Subject to the conditions and requirements of this paragraph, if all or a portion of the specification or drawing(s) is inadvertently omitted from an application, but the application contains a claim under § 1.55 for priority of a prior-filed foreign application, or a claim under § 1.78 for the benefit of a prior-filed provisional, nonprovisional, or international application, that was present on the filing date of the application, and the inadvertently omitted portion of the specification or drawing(s) is completely contained in the prior-filed application, the claim under § 1.55 or § 1.78 shall also be considered an incorporation by reference of the prior-filed application as to the inadvertently omitted portion of the specification or drawing(s).

This provision of the Rules allows for the incorporation by reference of clearly identified referenced patents, applications, or publications into a patent application at the filing thereof. This practice is a useful tool that allows the reliance upon disclosed subject matter from one document into another without having to literally provide the disclosed subject matter from the incorporated document verbatim into the incorporating document. The undersigned attorney's understanding of incorporation by reference is that it is a tool that provides patent practitioners the opportunity to garner incorporated information from the referenced document and include this information into the

incorporating application during prosecution; or to garner support for non-essential subject matter during prosecution or after issuance without adding new-matter to the original disclosure. Thus, this is somewhat of a prophylaxis in case of omission or the need to garner information at a later date, while avoiding addition of new-matter.

Respectfully, incorporation by reference is thus a useful tool during patent drafting, prosecution and after issuance by the applicant/patentee. However, no basis in law, or exception to established law requiring that for *prima facie* anticipation to be established, a single prior art reference disclose each element of the claim, is provided in the Office Action; and as noted above, the undersigned is unaware of such a basis or exception.

Accordingly, Applicants respectfully submit that a proper rejection for anticipation cannot be made based on multiple references, rendering the rejection of claims 1, 10 and 13-15 improper. Because a proper rejection has not been established, claims 1, 10 and 13-15 are patentable. Moreover, claims 2-9, 11-12 and 13-14, which depend from claims 1, 10 and 13, respectively are also patentable. Applicants respectfully further submit that rejections of claims 1, 10 and 13-15, if any, cannot properly be made final.

Rejections under 35 U.S.C. § 103

The rejection of claims 2-9 and 11-12 under 35 U.S.C. § 103(a) has been considered. While in no way conceding the propriety of the rejection, Applicants note that claims 2-9 and 11-12 depend from claims 1 and 10, respectively, either directly or indirectly. As such, because these claims depend from claims that are patentable for the reasons set forth above, claims 2-9 and 11-12 are also patentable.

Conclusion

In view the foregoing, applicant(s) respectfully request(s) that the Examiner withdraw the objection(s) and/or rejection(s) of record, allow all the pending claims, and find the application in condition for allowance.

If necessary, the Commissioner is hereby authorized in this, concurrent, and further replies to charge payment or credit any overpayment to Deposit Account Number

50-0238 for any additional fees, including, but not limited to, the fees under 37 C.F.R. §1.16 or under 37 C.F.R. §1.17.

If any points remain in issue that may best be resolved through a personal or telephonic interview, the Examiner is respectfully requested to contact the undersigned at the telephone number listed below.

Respectfully submitted on behalf of:
Phillips Electronics North America Corp.

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by: William S. Francos (Reg. No. 38,456)

Date: December 19, 2007

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